

## ***REMARKS***

This is a full and timely response to the outstanding Office Action mailed November 24, 2004. Upon entry of the amendment in this response claims 1-45 are pending. More specifically, claim 37 is amended. This amendment is specifically described hereinafter. It is believed that the foregoing amendment adds no new matter to the present application.

### **I. Present Status of Patent Application**

Claims 1 – 24, 27 – 36, 38, 39, 44 and 45 stand rejected under 35 U.S.C. § 101 as statutory double patenting. Claims 25, 26, and 43 stand rejected as being unpatentable under the doctrine of non-statutory double patenting. No grounds of rejection for independent claim 37 were provided; however, claim 37 will be addressed as if it is rejected under 35 U.S.C. § 101 as statutory double patenting

### **II. Discussion of Rejections**

#### ***A. Statutory Double Patenting***

Claims 1 – 24, 27 – 36, 38, 39, 42, 44 and 45 stand rejected under 35 U.S.C. § 101 as statutory double patenting. Specifically claims 1 – 13, 15 - 23, 27 – 36, 38, 39, 44 and 45 stand rejected as being the same as claims *Atkins et al.*, U.S. Pat. No. 6,292,568, hereinafter ‘568; and claims 14, 24, and 42 stand rejected as being the same as claims *Banker et al.*, U.S. Pat. No 6,005,938, hereinafter ‘938.

##### ***i. Statement of Law***

In order for statutory double patenting to exist, the “same invention” must be claimed twice. “ ‘Same invention’ means identical subject matter.” MPEP 804 (Emphasis added.) “A reliable test for double patenting under 35 U.S.C. 101 is whether a claim in the application could be literally infringed without literally infringing a corresponding claim in the patent. *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).” MPEP 804 (Emphasis Added.) If there is an embodiment of the invention that falls within the scope of one claim, but not the other, then identical subject matter is not defined by both claims and statutory double patenting does not

exist. MPEP 804.

**ii. *Applicants' Response to Rejections***

Applicants respectfully submit that the subject matter of claims 1 – 24, 27 – 36, 38, 39, 42, 44 and 45 is not identical to the subject matter of claims in '568 and '938. Exemplary and non-exclusive differences between the subject matter of the claims are shown below. For at least the reason that the subject matter of claims 1 – 24, 27 – 36, 38, 39, 42, 44 and 45 is not identical to the subject matter of claims in '568 and '938, Applicants respectfully request that these rejections be withdrawn.

**a. *Statement of Rejection for claims 1 – 7, 9 –12, 15 –21, 29 – 36, and 38 – 39***

Claims 1 – 7, 9 –12, 15 –21, 29 – 36, and 38 – 39 are rejected under 35 U.S.C. 101 as claiming the same invention of claim 1 and 2 (& 8 and 9) of prior U.S. Patent No. 6,292,568 B1 ('568). This is a double patenting rejection.

**1. *Applicants' Response***

Applicants' claims 1 – 7, 9 –12, 15 –21, 29 – 36, and 38 – 39 are NOT identical subject matter to Akins' claims 1, 2, 8, and 9, for at least the reason that the '568 claims include limitations not found in Applicants' pending claims and vice-versa. For the sake of simplicity, Applicants will point out some, but not all, limitations found in the '568 claims 1 and 8 that are not found in Applicants' pending claims. Applicants will not discuss the '568 dependent claims 2 and 9 in detail because the '568 claims 2 and 9 depend from the '568 claims 1 and 8, respectively, and consequently, the '568 claims 2 and 9 inherently include the limitations of their base claims. Thus, the '568 claims 2 and 9 inherently include limitations that are not found in Applicants' claims 1 – 7, 9 –12, 15 –21, 29 – 36, and 38 – 39.

**2. *Claim 1 of '568***

Claim 1 of '568 is as follows:

An apparatus for representing entitlements for instances of services having

entitlement IDs associated therewith in a receiver that receives the instances of services and the entitlement IDs, the apparatus comprising:

a memory having a starting entitlement ID and a map having entitlement values for entitlements that have been given to the receiver, **wherein the starting entitlement ID is used with the map to determine whether the receiver is entitled to a given instance of a service**, wherein the receiver grants access to the given instance of service only if the receiver is entitled to the given instance of service, the map represents a sequence of entitlement IDs, the starting entitlement ID is the first entitlement ID in the sequence of entitlement IDs, and the map is represented by an array of elements having entitlement values that represent the presence or absence of entitlement, and the difference in the sequence of entitlement IDs between the starting entitlement ID and the entitlement ID associated with the given instance of service is used to determine the index value for a given element in the array, wherein the given element has the entitlement value of the given instance of service. (Emphasis Added.)

Applicants respectfully submit that pending claims 1 – 7, 9 –12, and 29 – 36 do NOT include at least the above-emphasized limitation and are therefore NOT identical to the subject matter of claim 1. Furthermore, claims 1 – 7, 9 –12, and 29 –36 are also NOT identical to the subject matter of the ‘568 claim 1 because they include subject matter not found in the ‘568 claim 1. Therefore, claims 1-7, 9-12, and 29-36 could be literally infringed without literally infringing claim 1 of the ‘568 patent and the rejection should be withdrawn.

Applicants respectfully submit that pending claims 15 –21 and 38 – 39 are method claims which have different subject matter than the ‘568 claim 1. Therefore, claims 15-21 and 38-39 could be literally infringed without literally infringing claim 1 of the ‘568 patent and the rejection should be withdrawn.

### 3. *Claim 8 of ‘568*

Claim 8 of ‘568 is as follows:

A method of determining entitlements for instances of service in a receiver, the method comprising the steps, in the receiver, of:

receiving at least a first message having a starting entitlement ID and a map having entitlement values that represent entitlements of the receiver for instances of service;

storing in a memory at least the starting entitlement ID and the map of the first message;

receiving at least a second message having an entitlement ID associated with a given instance of service; and

determining whether the receiver is entitled to the instance of service by using the starting entitlement ID and the entitlement ID associated with the given instance of service to determine an element of the map which has the entitlement value of the given instance of service, **wherein the map is stored as an array, the starting entitlement ID is the first entitlement ID in a sequence of entitlement IDs including the entitlement ID associated with the given instance of service, and the difference in the sequence between the starting entitlement ID and the entitlement ID associated with the given instance of service is used to determine an element in the array having the entitlement value for the given instance of service.** (Emphasis Added.)

Applicants respectfully submit that pending claims 1 – 7, 9 –12, and 29 – 36 are NOT method claims and that they have different subject matter from the ‘568 claim 8. Therefore, claims 1 – 7, 9 –12, and 29 – 36 could be literally infringed without literally infringing claim 8 of the ‘568 patent and the rejection should be withdrawn.

Applicants respectfully submit that pending method claims 15 – 21 are substantially different the ‘568 claim 8, and are therefore NOT identical to the subject matter of the ‘568 claim 8. One difference, among other differences, is that pending independent claim 15 includes the limitation of “sending a message to the receiver ....”, and the ‘568 claim 8 fails to include that limitation. Therefore, claims 15-21 could be literally infringed without literally infringing claim 8 of the ‘568 patent and the rejection should be withdrawn.

Regarding claim 38 and 39, claims 38 and 39 are NOT identical subject matter to the ‘568 claims 8 and 9. The above emphasized limitations of the ‘568 claim 8 are not found in pending claims 38 – 39. Therefore, claims 38 and 39 could be literally infringed without literally infringing claim 8 of the ‘568 patent and the rejection should be withdrawn.

**b. Statement of Rejection for claims 6, 20, 34 and 39**

Claims 6, 20, 34 and 39 are rejected under 35 U.S.C. 101 as claiming the same invention of claim 8 of prior U.S. Patent No. 6,292,568 B1 (‘568). This is a double patenting rejection.

### **1. Applicants' Response**

Applicants' claims 6, 20, 34 and 39 are NOT identical subject matter to the '568 claim 8 for at least the reason that the '568 claim 8 includes limitations not found in Applicants' pending claims and vice-versa. For the sake of simplicity, Applicants will point out some, but not all, limitations found in the '568 claim 8 that are not found in Applicants' pending claims.

### **2. Claim 8 of '568**

Claim 8 of '568 is as follows:

A method of determining entitlements for instances of service in a receiver, the method comprising the steps, in the receiver, of:

receiving at least a first message having a starting entitlement ID and a map having entitlement values that represent entitlements of the receiver for instances of service;

storing in a memory at least the starting entitlement ID and the map of the first message;

receiving at least a second message having an entitlement ID associated with a given instance of service; and

determining whether the receiver is entitled to the instance of service by **using the starting entitlement ID and the entitlement ID associated with the given instance of service to determine an element of the map which has the entitlement value of the given instance of service**, wherein the map is stored as an array, the starting entitlement ID is the first entitlement ID in a sequence of entitlement IDs including the entitlement ID associated with the given instance of service, and the difference in the sequence between the starting entitlement ID and the entitlement ID associated with the given instance of service is used to determine an element in the array having the entitlement value for the given instance of service. (Emphasis Added.)

Applicants respectfully submit that pending claims 6 and 34 are NOT method claims and that they have different subject matter from the '568 claim 8. Therefore, claims 6 and 34 could be literally infringed without literally infringing claim 8 of the '568 patent and the rejection should be withdrawn.

Applicants respectfully submit that pending method 20 and 39 do NOT include at least the above emphasized limitation and are therefore NOT identical to the subject matter of the '568 claim 8. Furthermore, claims 20 and 39 are also NOT identical to the '568 claim 8 because they include subject matter not found in the '568 claim 8. Therefore, claims 20 and 39 could be

literally infringed without literally infringing claim 8 of the '568 patent and the rejection should be withdrawn.

**c. Statement of Rejection for claims 8 and 22**

Claims 8 and 22 are rejected under 35 U.S.C. 101 as claiming the same invention of claim 2 of prior U.S. Patent No. 6,292,568 B1 ('568). This is a double patenting rejection.

**1. Applicants' Response**

Applicants' claims 8 and 22 are NOT identical subject matter to the '568 claim 2 for at least the reason that the '568 claim 2 depends on the '568 claim 1, which includes limitations that are NOT found in pending claims 8 and 22.

Furthermore, pending claim 8 depends from pending claim 7, which depends from pending claim 3, which depends from pending claim 2, which depends from pending claim 1. Therefore, pending claim 8 implicitly includes all of the limitations its base claim and all intervening claims, and all of those limitations are not found in the '568 claim 2.

Similarly, pending claim 22, depends from pending claim 21, which depends from pending claim 17, which depends from pending claim 16, which depends from pending claim 15. Therefore, pending claim 22 implicitly includes all of the limitations its base claim and all intervening claims, and all of those limitations are not found in the '568 claim 2. Furthermore, pending claim 22 is a method claim having different subject matter than the '568 claim 2. Therefore, claims 8 and 22 could be literally infringed without literally infringing claim 2 of the '568 patent and the rejection should be withdrawn.

**d. Statement of Rejection for claims 13 and 23**

Claims 13 and 23 are rejected under 35 U.S.C. 101 as claiming the same invention of claim 3 of prior U.S. Patent No. 6,292,568 B1 ('568). This is a double patenting rejection.

**1. Applicants' Response**

Applicants' claims 13 and 23 are NOT identical subject matter to the '568 claim 3 for at least the reason that the '568 claim 3 includes limitations not found in pending claims 13 and 23

and vice-versa. For the sake of simplicity, Applicants will point out some, but not all, limitations found in the '568 claim 3 that are not found in Applicants' pending claims.

2. *Claim 3 of '568*

An apparatus for representing entitlements for instances of services having entitlement IDs associated therewith in a receiver that receives the instances of services and the entitlement IDs, the apparatus comprising:

a memory having a starting entitlement ID and a map having entitlement values for entitlements that have been given to the receiver, **wherein the starting entitlement ID is used with the map to determine whether the receiver is entitled to a given instance of a service**; and wherein:

the receiver grants access to the given instance of service only if the receiver is entitled to the given instance of service;

the starting entitlement ID and the map are set in response to a message received in the receiver;

the message contains a message starting entitlement ID and message map from which the starting entitlement ID and the map are set;

the receiver is given entitlements by at least one entitlement agent;

each entitlement agent has a map for representing entitlements that have been given to the receiver;

the message further specifies a given entitlement agent; and

the message starting entitlement ID and the message map are used to set a starting entitlement ID and a map in the list for the given entitlement agent. (Emphasis Added.)

Applicants respectfully submit that pending claim 13 does NOT include at least the above emphasized limitation and is therefore NOT identical to the subject matter of the '568 claim 3. Furthermore, pending claim 13 is also NOT identical to the '568 claim 3 because it includes subject matter not found in the '568 claim 3. Therefore, claim 13 could be literally infringed without literally infringing claim 3 of the '568 patent and the rejection should be withdrawn.

Applicants respectfully submit that pending claim 22 is a method claim, which has different subject matter than '568 claim 3. Therefore, claim 22 could be literally infringed without literally infringing claim 3 of the '568 patent and the rejection should be withdrawn.

**e. Statement of Rejection for claims 14, 24 and 42**

Claims 14, 24 and 42 are rejected under 35 U.S.C. 101 as claiming the same invention of claim 1 of prior U.S. Patent No. 6,005,938 ('938). This is a double patenting rejection.

**1. Applicants' Response**

Applicants' claims 14, 24 and 42 are NOT identical subject matter to the '938 claim 1 for at least the reason that the '938 claim 1 includes limitations not found in Applicants' claims and vice-versa. For the sake of simplicity, Applicants will point out some, but not all, limitations found in the '938 claim 1 that are not found in Applicants' pending claims.

**2. Claim 1 of '938**

A method of protecting a given encrypted instance of a service that a service provider provides via a network to a subscriber, the method being practiced in apparatus by means of which the subscriber accesses instances of the service for limited periods of time and the method comprising the steps of:

**receiving a first message from the service provider, the first message including at least a period specifier which specifies a given period of time and an authorization for the service;**

receiving a second message from the service provider, the second message being associated with the given instance and including at least an identification of the service, a time specifier which specifies a time, and first decryption information for the given instance;

receiving the given instance; and

using the first decryption information and second decryption information accessible to the apparatus to decrypt the given instance only if the identification of the service from the second message indicates the same service as the authorization therefor from the first message and the time specified by the time specifier from the second message is within the period specified by the period specifier from the first message. (Emphasis Added.)

Applicants respectfully submit that pending claim 14 is not a method claim and that pending claim 14 has different subject matter than the '938 claim 1. Therefore, claim 14 could be literally infringed without literally infringing claim 1 of the '938 patent and the rejection should be withdrawn.

Applicants respectfully submit that pending claims 24 and 42 do NOT include at least the above emphasized limitation and are therefore NOT identical to the subject matter of the '938

claim 1. Furthermore, pending claims 24 and 42 are also NOT identical to the '938 claim 1 because pending claims 24 and 42 include subject matter not found in the '938 claim 1. Therefore, claims 24 and 42 could be literally infringed without literally infringing claim 1 of the '938 patent and the rejection should be withdrawn.

**f. Statement of Rejection for claims 27 and 44.**

Claims 27 and 44 are rejected under 35 U.S.C. 101 as claiming the same invention of claim 12 of prior U.S. Patent No. 6,292,568 B1 ('568). This is a double patenting rejection.

**1. Applicants' Response**

Applicants' claims 27 and 44 are NOT identical subject matter to the '568 claim 12 for at least the reason that the '568 claim 12 depends on the '568 claim 8, which as previously described hereinabove includes limitations that are NOT found in the pending claims 27 and 44 nor are the limitations found in the base claims 15 and 37, respectively.

Furthermore, pending claim 27 depends from pending claim 15. Therefore, pending claim 27 implicitly includes all of the limitations its base claim, and all of those limitations are not found in the '568 claim 12.

Similarly, pending claim 44 depends from pending claim 37. Therefore, pending claim 44 implicitly includes all of the limitations its claim 37. Claim 44 does not include all of the limitations of the '568 claim 12. Therefore, claims 27 and 44 could be literally infringed without literally infringing claim 12 of the '568 patent and the rejection should be withdrawn.

**g. Statement of Rejection for claims 28 and 45.**

Claims 28 and 45 are rejected under 35 U.S.C. 101 as claiming the same invention of claim 13 of prior U.S. Patent No. 6,292,568 B1 ('568). This is a double patenting rejection.

**1. Applicants' Response**

Applicants' claims 28 and 45, which have pending claims 15 and 37 as their respective base claims, are NOT identical subject matter to the '568 claim 13 for at least the reason that the '568 claim 13 depends on the '568 claim 12, which depends on the '568 claim 8. As previously

described hereinabove, the '568 claim 8 includes limitations that are NOT found in pending claims 15 and 37 nor in pending claims 28 and 45. Therefore, claims 28 and 45 could be literally infringed without literally infringing claim 12 of the '568 patent and the rejection should be withdrawn.

***h. Statement of Rejection for claim 37***

Claim 37 is rejected under 35 U.S.C. 101 as claiming the same invention of claims 10 and 11 of prior U.S. Patent No. 6,292,568 B1 ('568). This is a double patenting rejection.

***1. Applicants' Response***

Applicants have amended claim 37 to include a limitation not found in claims 10 or 11. Therefore, claim 37 could be literally infringed without literally infringing claims 10 or 11 of the '568 patent and the rejection should be withdrawn.

***i. Statement of Rejection for claim 40.***

Claim 40 is rejected under 35 U.S.C. 101 as claiming the same invention of claim 10 of prior U.S. Patent No. 6,292,568 B1 ('568). This is a double patenting rejection.

***1. Applicants' Response***

Applicants' pending amended claim 40 is NOT identical subject matter to the '568 claim 10 for at least the reason that amended claim 40 includes limitations that are NOT found in the '568 claim 10. Claim 40 depends from claim 38, depends from claim 37, which includes limitations NOT found in the '568 claim 10. Thus, pending claim 40 is NOT identical to the '568 claim 10. Therefore, claim 40 could be literally infringed without literally infringing claim 10 of the '568 patent and the rejection should be withdrawn.

**j. Statement of Rejection for claim 41**

Claim 41 is rejected under 35 U.S.C. 101 as claiming the same invention of claim 11 of prior U.S. Patent No. 6,292,568 B1 ('568). This is a double patenting rejection.

**1. Applicants' Response**

Claim 41 depends from claim 40, which depends from claim 38, which depends from claim 37. Claim 37 includes limitations NOT found in the '568 claim 10. Thus, pending claim 41 is rendered is NOT identical to the '568 claim 10. Therefore, claim 40 could be literally infringed without literally infringing claim 10 of the '568 patent and the rejection should be withdrawn.

**B. Non-Statutory Double Patenting**

Claims 25, 26 and 43 stand rejected under the judicially created doctrine of double patenting over claim 22 of *Banker et al.*, U.S. Patent No. 6,005,938.

**i. Applicants' Response**

Applicants have filed a terminal disclaimer addressing claims 25, 26, and 43 and the '938 patent in a separate mailing. Therefore, grounds of the rejection of claims 25, 26, and 43 are rendered moot.

**CONCLUSION**

Applicants respectfully submit that all claims are now in proper condition for allowance, and respectfully request that the Examiner pass this case to issuance. If, in the opinion of the Examiner, a telephonic conference would expedite the examination of this matter, the Examiner is invited to call the undersigned attorney at (770) 933-9500.

Respectfully submitted,

THOMAS, KAYDEN, HORSTEMEYER  
& RISLEY, L.L.P.  
Suite 1750  
100 Galleria Parkway N.W.  
Atlanta, Georgia 30339  
(770) 933-9500

  
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**Jeffrey R. Kuester**  
**Registration Number 34,367**